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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,029	09/26/2001	Marcey L. Kelley	IL-10707	9891

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,029

Applicant(s)

KELLEY ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/2/2004 has been entered.

Claims Status

Claim 6 is pending. Claims 1-5 and 7-17 have been cancelled. Claim 6 is rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 6 includes many instances of the word "interpreting" such as: (1) interpreting which files will be affected, (2) interpreting which directories will be affected, (3) interpreting

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the operating system type, version and architecture, (4) interpreting dependencies on other layered products, and (5) interpreting how much memory and disk space is needed. Particularly, the specification does not explain what is being interpreted, for example consider the limitation “interpreting which files will be affected by the installation of said software patches.” It is unclear what feature(s) of each file are being interpreted. Furthermore, the outcome of the interpretation is unclear. Clearly, the specification does not contain a clear and concise description of the means by which a computer-implemented method is able to interpret above software entities, so as to enable the skilled artisan to make and/or use the invention. For purposes of this examination, limitations prefixed by “interpreting” will not be given patentable weight.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 includes multiple references to determining software patches such as:

- determining which of said software patches should be applied to said client's systems,
- determining which of vendor's upgrades and patches have been applied to client's systems
- determining which said software upgrades and patches should be or should have been applied to said client's systems,

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- determining which software patches should be installed by determining the needed software patches and the not needed software patches

The scope of the invention cannot be determined as the difference, if any, between above limitations is unclear.

Claim 6 includes multiple references to collecting/collection of such as:

- collecting said software patches from said vendors by downloading them from said vendor's ftp sites
- collection of said patches and upgrades from said vendor's and downloading said patches and upgrades to client systems

The scope of the invention cannot be determined as the difference, if any, between above limitations is unclear.

Claim 6 includes multiple references to interpreting such as:

- interpreting the operating system type, version and architecture said software patches apply to
- interpreting the operating system
- interpreting the operating system version
- interpreting the operating system architecture the patch applies to

The scope of the invention cannot be determined as the difference, if any, between above limitations is unclear.

Claim 6 includes multiple references to determining dependencies such as:

- determining how dependencies on other patches, or software upgrades affect the installation of a patch
- determining how dependencies on other software upgrades affect the installation of a patch

The scope of the invention cannot be determined as the difference, if any, between above limitations is unclear.

There is insufficient antecedent basis for “said software patches” which is included in lines 4, 6, 8, 11, 12 and 27 of claim 6.

Claim 6 recites “determining which of vendor’s upgrades and patches have been applied to client’s systems.” The scope of the invention cannot be determined because it is unclear whether above vendor’s upgrades are the same as the vendor’s upgrades included in the preamble. Furthermore, it is unclear whether above patches are the same patches as included in the preamble. Still further, it is unclear whether above client’s systems are the same client’s systems as included in the preamble.

Claim 6 recites “determining which said software upgrades and patches should be or should have been applied to said clients systems.” The scope of the invention cannot be determined because it is unclear whether above patches are the same as the patches included in the preamble.

Claim 6 recites “interpreting how much memory and disk space is needed to install software upgrades and installing said software patches.” The scope of the invention cannot be

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determined because it is unclear whether above “software upgrades” are the same as “vendor’s upgrades” included in the preamble.

Claim 6 recites “determining how dependencies on other patches, or software upgrades affect the installation of a patch.” The scope of the invention cannot be determined because it is unclear what comprises “other patches,” “other software upgrades,” and “a patch.”

Claim 6 recites “determining how dependencies on other software upgrades affect the installation of a patch.” The scope of the invention cannot be determined because it is unclear what comprises “other software upgrades” and “a patch.”

Claim 6 recites “determining which files will be affected by the installation of a patch.” The scope of the invention cannot be determined because it is unclear what comprises “a patch.”

Claim 6 recites “determining which directories will be affected by the installation of a patch.” The scope of the invention cannot be determined because it is unclear what comprises “a patch.”

Claim 6 recites “checking the permissions and ownership of the files referenced in the patch and ensuring that the system software is authentic.” The scope of the invention cannot be determined because it is unclear what comprises “the system software.”

Claim 6 recites “determining which software patches should be installed by determining the needed software patches and the not needed software patches.” The scope of the invention cannot be determined because it is unclear what comprises “which software patches,” and “the needed software patches” and “the not needed software patches.”

Claim 6 recites “interpreting which files will be affected by the installation of said software patches.” There is insufficient antecedent basis for “the installation.”

Claim 6 recites “interpreting the operating system type, version and architecture said software patches apply to.” There is insufficient antecedent basis for “the operating system type,” and “the version,” and “the architecture.”

Claim 6 recites “interpreting dependencies on other layered products.” The scope of the invention is difficult to determine because it is unclear what comprises “other layered products.”

Claim 6 recites “determining which of vendor’s upgrades and patches have been applied to client’s systems.” The scope of the invention cannot be determined because it is unclear what comprises: (1) vendor’s upgrades, (2) vendor’s patches, (3) client’s systems.

Claim 6 recites “determining which said software upgrades and patches should be or should have been applied to said clients systems.” The scope of the invention cannot be determined because it is unclear what comprises: (1) software upgrades, and (2) software patches and (3) clients systems.

Claim 6 recites “collection of said patches and upgrades from said vendor’s and downloading said patches and upgrades to client systems.” The scope of the invention cannot be determined because it is unclear what comprises “client systems.” Is it the same client’s systems included in the preamble?

Claim 6 recites “determining how dependencies on other layered products affect the installation of said patches and upgrades” and also “interpreting dependencies on other layered products.” The scope of the invention cannot be determined because it is unclear how determining is different from interpreting. Furthermore, the scope of the invention cannot be determined because it is unclear what comprises “other layered products.”

Claim 6 recites “determining how dependencies on other patches, or software upgrades affect the installation of a patch.” The scope of the invention cannot be determined because it is unclear what comprises “other patches” and “other software upgrades.”

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Conference

Publication: Secure Software Distribution System by T. Bartoletti et al (hereafter Bartoletti), as provided by applicant.

Claim 6:

Bartoletti discloses:

- determining which of said software patches should be applied to said client's systems [page 4, par 2, line 2]
- collecting said software patches from said vendors by downloading them from said vendor's ftp sites [page 5, par 1]
- determining which of vendor's upgrades and patches have been applied to client's systems [page 4, par 2, line 2]
- determining which said software upgrades and patches should be or should have been applied to said clients systems [page 4, par 2, line 2]

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- collection of said patches and upgrades from said vendor's and downloading said patches and upgrades to client systems [page 4, par 1, lines 4,5]
- determining how much memory is needed to install said patch and upgrades [page 4, par 2, line 5]
- determining how dependencies on other layered products affect the installation of said patches and upgrades [page 4, par 2, line 6]
- determining how dependencies on other patches, or software upgrades affect the installation of a patch [page 4, par 2, line 6]
- determining how dependencies on other software upgrades affect the installation of a patch [page 4, par 2, lines 4-6]
- determining which files will be affected by the installation of a patch [page 4, par 2, lines 4-6],
- determining which directories will be affected by the installation of a patch [page 4, par 2, line 7]
- backing-out said software patches that have been applied to said client's systems [page 4, par 1, line 3, par 3]
- checking the permissions and ownership of the files referenced in the patch and ensuring that the system is authentic [page 5, par 1, line 12]
- determining which software patches should be installed by determining the needed software patches and the not needed software patches [page 6, par 2, line 16]
- distributing said needed software patches to said client's systems [page 6, par 2 line 18-20],

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- installing said needed software patches [page 6, par 2, lines 18-20]

Response to Arguments

Applicant's arguments filed 7/2/2004 have been fully considered but they are not persuasive.

Applicant Argues:

Applicant states in the second paragraph on page 6 "The Bartoletti reference is an early paper by the inventors in the subject Application, Marcey L. Kelley, Lauri A. Dobbs and Tony Bartoletti. The paper is a preliminary report describing the project that had been started and eventually produced the invention in the subject patent application. The paper describes the problems that are expected to be encountered and the approach the inventors intended to use in solving the problems. The paper did not describe a working system. The paper states in the Abstract on page 1, "The Secure Software Distribution System (SSDS) will" The paper states on page 6, lines 3-4., "The goal of the project is to develop a proof-of-concept prototype over several phases of development."

Examiner Responds:

Examiner is not persuaded. MPEP § 2132.01 states:

If one discloses his or her own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. In addition, the prior art need not be identical to the claimed invention but will bar patentability if it is an obvious variant thereof. In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1966). See MPEP § 706.02 regarding the effective

U.S. filing date of an application.

Clearly instant inventors disclosed their work one year before filing for a US Patent and thus are barred from obtaining a patent. Above excerpt from the MPEP states that the prior art need not be identical as long as it is an obvious variant of the invention and thus it is not material that the paper did not describe a “working system.” Examiner maintains the cited prior art is an obvious variant of the present application for parent.

Furthermore, for the sake of arguing, assume that examiner is able to reject above amended claims under 35 USC § 103. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth by this Office:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Examiner maintains the differences between instant application and the prior art would have been obvious to the skilled artisan. Above conclusion is substantiated by the fact that the authors of the conference publication were able to produce instant invention. It is logical that other skilled artisans would have also been able to produce instant invention based on the disclosure in the cited prior art, i.e., above conference publication authored by the inventors of instant invention. Examiner maintains a patent may not be obtained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

12/4/2004


SAFET METJAHIC
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